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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,263	03/08/2004	Laurie A. Gallagher	H0005976	2374

7590 12/11/2006

Honeywell International, Inc.
Patent Legal Services
101 Columbia Road
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EXAMINER

MRUK, BRIAN P

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/796,263

Applicant(s)

GALLAGHER ET AL.

Examiner

Brian P. Mruk

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is in response to Applicant's amendment filed September 25, 2006. Applicant has amended claim 42. Currently, claims 1-44 remain pending in the application.
2. The text of those sections of Title 35 U.S. Code not included in this action can be found in the prior Office action, Paper No. 20060616.
3. The rejection of claim 42 under 35 U.S.C. 112, second paragraph, for containing the phrase "more than about 0 wt.%" in lines 3, 5, 6, 7 and 8 is maintained for the reasons of record.
4. The rejection of claims 1-35 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mitra et al, U.S. Patent No. 6,673,761, is maintained for the reasons of record.
5. The rejection of claims 1-35 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ouellette et al, U.S. 2004/0244132, is maintained for the reasons of record.

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6. The rejection of claims 1-3, 5-7, 10-18 and 20-22 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bragulla, WO 2004/024857, is maintained for the reasons of record.

7. The rejection of claims 36-44 under 35 U.S.C. 103(a) as being unpatentable over Mitra et al, U.S. Patent No. 6,673,761, is maintained for the reasons of record.

8. The rejection of claims 36-44 under 35 U.S.C. 103(a) as being unpatentable over Ouellette et al, U.S. 2004/0244132, is maintained for the reasons of record.

Response to Arguments

9. Applicant's arguments filed September 25, 2006 have been fully considered but they are not persuasive.

Applicant argues that the phrase "more than about 0 weight %" recited in instant claim 42 is not indefinite. However, the examiner respectfully disagrees. Specifically, the examiner maintains that it is unclear what values are encompassed by "about 0". Furthermore, the examiner notes that the components recited after the phrases "about 0 wt.%" in lines 3, 4, 6, 7 and 8 of claim 42 are required in independent claim 36, which also makes the claim vague and indefinite, since these components don't need to be present in dependent claim 42 (i.e. with the value zero). The examiner suggests that

the phrase "more than about 0" should be amended to recite "more than 0" to render the claim definite.

Applicant argues that each of Mitra et al, U.S. Patent No. 6,673,761, Ouellette et al, U.S. 2004/0244132, and Bragulla, WO 2004/024857, fail to teach or suggest in general a composition that contains a brake dust barrier composition that provides brake dust efficacy (i.e. the references fail to teach compositions that are used in automotive applications). However, in response to applicant's argument that the references fail to teach compositions that are used in automotive applications to provide brake dust efficacy, the examiner asserts that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, the examiner asserts that each of the above listed references clearly teach compositions that contain all of the required components in the amounts required in the instant claims, and therefore, meet the limitations of the instant claims. Furthermore, since the prior art references include all of the required components, the examiner asserts that the compositions would clearly be capable of providing brake dust efficacy. It is also noted by the examiner that the preamble of independent claim 1 is directed toward a cleaning formulation adapted to be applied to a surface, which is clearly taught by all of the prior art references.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Mruk whose telephone number is (571) 272-1321. The examiner can normally be reached on Mon-Thurs (7:00AM-5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BPM

Brian P Mruk
December 6, 2006

Brian P. Mruk

Brian P Mruk
Primary Examiner
Art Unit 1751